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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,381	10/16/2003	Thierry Fleurence	1948-4821	2245
27123	7590	03/24/2008		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER PICKARD, ALISON K	
			ART UNIT	PAPER NUMBER
			3676	
			NOTIFICATION DATE	DELIVERY MODE
			03/24/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/688,381	<b>Applicant(s)</b> FLEURENCE, THIERRY	
	<b>Examiner</b> Alison K. Pickard	<b>Art Unit</b> 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.  
4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. After further consideration, the allowability of the claims has been withdrawn. The examiner regrets any inconvenience.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester (6,190,751) in view of Sellew.

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Sellew teaches a seal having flexible sheet and an orifice. Sellew teaches using a lip(s) to improve sealing particularly where there are imperfections in the mating surface (see col. 2, lines 28-39). Thus, Sellew provides a teaching of a lip at any location where improved sealing is necessary. Providing the lip(s) only at the first surface of the first side (i.e. no lip at the second surface) is considered obvious in a situation where that is the only location there may be imperfections. Additionally, using that shape of the lips is obvious absent any showing of criticality. See *In re Dailey*, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a lip on the first surface as taught by Sellew to improve

Art Unit: 3676

sealing. Regarding claim 7, the lip would be made of material 32 and would have a different hardness than the sheet comprising all materials 32, 34, 36, etc.

Regarding the limitation that the sheet is formed by extrusion, this is considered a process limitation within a product claim and is given little patentable weight. However, Sylvester does disclose the sheet can be extruded.

Regarding claim 3, Sylvester does not specifically disclose cellular EPDM. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin* 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use cellular EPDM in the sheet.

#### ***Response to Arguments***

4. Upon further consideration, allowability has been withdrawn. As stated above, Sylvester discloses a seal comprising most of the structure except the sealing lips. It is well known to use a sealing lip to improve the sealing ability of a gasket. Sellew, for example, teaches providing a lip where the additional sealing is needed and not providing a lip if it is not needed (see Figure 4 versus 5 and 6). Given this teaching, it is considered obvious to use a lip anywhere such additional sealing is needed and to not use a lip if it is not needed. Applicant has not stated any criticality in forming the gasket without a lip on the second surface. In fact, the specification states the lip could be present in this location. Providing a lip at only desired locations would produce expected results of additional sealing.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alison K. Pickard/  
Primary Examiner, Art Unit 3676

AP